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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,039	09/07/2000	Christopher Lee Tobey	JP920000169US1	1586

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SCHMEISER, OLSEN + WATTS  
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LATHAM, NY 12110

EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/657,039

**Applicant(s)**

TOBEY, CHRISTOPHER LEE .

**Examiner**

Carolyn M. Bleck

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,13,15,16,24-29,34,35,38-41 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,13,15,16,24-29,34,35,38-41 and 43-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 21 July 2005. Claims 1,3,4,7,13,15,16,24-29,34,35,38-41 and 43-54 are pending. Claims 43-54 are newly added.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-33, 36-37, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 30-33, line 1, lack proper antecedent basis. These claims depend on claim 8, which has been cancelled. For purposes of applying prior art, claims 30-33 are rejected for the same reasons as claims 26-29.

(B) Claims 36-37, line 1, lack proper antecedent basis. These claims depend on claim 18, which has been cancelled. For purposes of applying prior art, claims 36-37 are rejected for the same reasons as claims 26-27.

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(C) Claim 43, line 1, lacks proper antecedent basis. Claim 43 depends on claim 42, which has been cancelled. For purposes of applying prior art, claim 43 is assumed to depend on claim 1.

(D) The Examiner notes that claims 1, 13, and 24 recite "assigning a unique identifier to each said asset." The Examiner respectfully submits that it is unclear in these claims whether the unique identifier is the same as the asset tag or if it is a different identifier. Appropriate clarification is requested.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7, 13, 24, 26, 27, 34-35, 38-39, and 43-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney (6,392,543) in view of PALM (PALM User's Manual, September 1989) and Maynard (5,949,335).

(A) As per claims 1, 26, 27, 34-35, 38-39, 43, 48, and 53, Maloney discloses a method for tracking the removal and use of specific objects comprising (Abstract):

(a) cataloguing a plurality of mobile objects (Fig. 13, col. 1 lines 18-30, col. 2 line 55 to col. 3 line 5);

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(b) tagging the plurality of mobile objects with a bar code identifier (col. 3 line 65 to col. 4 line 40);

(c) checking out and removing the mobile object from the storage unit, the mobile object being brought to a first site, for example, a vehicle, returning the mobile object to the storage site, checking the mobile object back into the storage site, where upon returning the object to the storage site the user rescans the bar code, and then checking the object out again to a second site, for example, another vehicle (col. 2 line 55 to col. 3 line 20, col. 4 lines 17-49, col. 6 lines 36-52, col. 9 line 65 to col. 10 line 21);

(d) assigning an identification tag in the form of a bar code to each mobile object (col. 3 line 65 to col. 4 line 40, col. 10 lines 1-21); and

(e) recording the identification codes of objects periodically to maintain a log of objects that are removed from the storage site (col. 16 lines 7-36).

Maloney does not expressly disclose recording the location of each said asset with respect to said central site in an electronic database, recording exit of each asset from a current site in said database, recording an intended destination in said database, and verifying entry of each asset at the destination site, being a new current location, in said database.

PALM discloses a database system for maintaining a record on each item, including the location of the item, using a barcode reader to scan the barcode label to determine locations of the item (1-1, 2-4, 2-5), wherein an item is charged to a user, which is the office location of the item with respect to a central files (reads on "recording the location of each said asset with respect to said central site"), wherein an item, upon

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leaving the office of the user, is recorded in the database (reads on "recording exit of each asset from a current site in said database"), wherein an item, upon leaving the office of a user is then charged to a new location in the database (reads on "recording an intended destination in said database"), wherein upon receiving the item at the new location, another user wands the item and the database is updated with the new location of the item (4-1, 4-2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of PALM within the method of Maloney with the motivation of providing online access to the location of all items (PALM; 1-1) and tracking objects in a way that is tamperproof, and reducing the potential for human error in the sign-in, sign-out procedures for the objects (Maloney; col. 1 lines 18-44).

As per the recitation of "a tag comprising an asset tag barcode, a part number, or a serial number barcode, and a SDS number, said SDS number...", the Examiner respectfully submits that the differences between the prior art and the tag in claim 1 is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The step of tagging an item would be performed the same regardless of the data on the tag. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that

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cannot alter how the process steps are to be performed to achieve the utility of the invention."

However, even if it is assumed the data on the tag is given patentable weight, the Examiner respectfully submits that **to be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, appears to be the case here. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961). For example, the tag would have to be used in another step in the method claim, such as a step of recording a location based on the tag, for the specific tag to be given patentable weight.

It is clear from the Maloney reference that the method is applicable for tracking a wide variety of objects (col. 3 lines 1-5). However, the reference does not expressly provide for tracking hardware and software computer assets. Thus, the Examiner provides Maynard as evidence of tracking these assets. Note, Maynard discloses the asset being processors, work stations, monitors, printers, scanners and network servers, and software (col. 1 lines 50-67).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Maynard within the method of Maloney and PALM with the motivation of preventing theft throughout the supply chain (Maynard; col. 1 lines 18-22).

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(B) As per claim 7, Maloney, PALM, and Maynard do not expressly disclose “determining whether an asset should be retained, and thus stored for further use, or withdrawn from use.” It is respectfully submitted that that it is well known in the art of asset management, specifically in computer hardware and software asset management to determine whether a particular device should be retained and put into use again, or should be withdrawn from use because the technology is obsolete. Thus, at the time the invention was made it would have been obvious to one skilled in the art to modifying the method taught by Maloney, PALM, and Maynard collectively to include determining whether an asset should be retained, and thus stored for further use, or withdrawn from use with the motivation of ensuring the devices are in proper condition for use.

(C) System claim 13 repeat the subject matter of method claim 1, respectively, as a set of apparatus elements rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Maloney, PALM, and Maynard in the above rejections of claim 1, it is readily apparent that the system disclosed collectively by Maloney, PALM, and Maynard includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(D) Claim 24 repeats the subject matter of method claim 1, respectively, as a series of computer program product carried on a storage medium rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by



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the collective teachings of Maloney, PALM, and Maynard in the above rejection of claim 1, it is readily apparent that the system disclosed collectively by Maloney, PALM, and Maynard includes a computer program product to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(E) As per claims 44-46, the Examiner respectfully submits that Applicant's Background of the Invention (pg. 1) discloses a system wherein there is a warehouse and a location for manufacturing the product, wherein the location of goods is tracked in the warehouse from arrival at the storage facility until the time the goods are sold or are removed from the storage facility for another reason, such as inclusion in a manufactured product (pg. 1). As per the recitation of the warehouse and build facility being in the same or different sites, the Examiner respectfully submits that it is well known in the art to organize these facilities in either configuration based on the efficiency with which products can be built.

(F) As per claims 47 and 52, PALM discloses determining the location of an item by scanning the barcode of the item (4-1, 4-2). By scanning the barcode of the item, the user is able to determine if the item is located in a user's office, in central files, or charged to another user and has not yet arrived (4-1, 4-2).

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(G) Claim 54 repeats claims 44 and 47, and is therefore rejected for the same reasons as those claims, and incorporated herein.

6. Claims 3-4, 15-16, 25, 28-29, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney (6,392,543), PALM (PALM User's Manual, September 1989), and Maynard (5,949,335) as applied to claims 1, 13, and 24 above, and further in view of Guthrie et al. (5,289,372).

(A) As per claims 3 and 25, the relevant teachings of Maloney, PALM, and Maynard, and the motivation for their combination is as discussed in the rejections above, and incorporated herein.

Maloney, PALM, and Maynard fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and on each configuration of a said asset at said central site, updating said configuration information on said database.

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a piece of equipment and automatically communicates configuration change information to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Maloney, PALM, and Maynard with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering, installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

(B) As per claim 4 and 41, the Examiner respectfully submits that while the applied prior art does not explicitly disclose an IP address, it is well known in the art to use IP addresses to identify devices. The motivation being to properly locate hardware on a network.

(C) Claim 15 repeats the same limitations as claim 3, and is therefore rejected for the same reasons given for claim 3, and incorporated herein.

(D) As per claim 16, Guthrie discloses storing hardware configuration information for a piece of equipment (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

(E) As per claims 28-29, the Examiner respectfully submits that notifying a user of a delivery via fax or other form of communication is well known in the art. For example, a user who orders a computer is notified in advance via email or fax that the delivery is arriving. In addition, installing and testing a computer upon delivery is also well known

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in the art. For example, the IT staff typically is required to test any hardware being added to a corporate network. The motivation being to ensure the products work correctly.

(F) As per claim 40-41, Maynard discloses storing asset information about software (col. 1 lines 50-67).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1,3,4,7,13,15,16,24-29,34,35,38-41 and 43-54 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches an integrated reusable pallet having data collection devices and method for using shipping conveyances (5,662,048), facility and method for tracking physical assets (6,614,349), package and mail delivery system (6,721,617), and method and system for determining the inventory and location of assets (US 2002/0008621 A1).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-

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6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. **Any response to this action should be mailed to:**

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**Or faxed to:**

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

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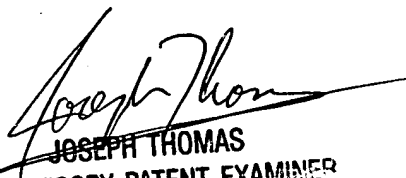
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Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

September 29, 2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600